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Supreme Court of the United States

OCTOBER TERM, 1942

NO. 568

THE CONSOLIDATED EXPANDED METAL
COMPANIES, Petitioner,

v.

UNITED STATES GYPSUM COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT
THEREOF.

WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.



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PETITION FOR WRIT OF CERTIORARI.

*To the Honorable the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioner, The Consolidated Expanded Metal Companies, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that court entered on October 6, 1942.

Summary Statement of the Matter Involved.

This is an infringement suit based on patent 1,950,372 which issued to petitioner on March 6, 1934 as the assignee of Leonard W. Cross¹. It is for an improved "expanded metal" free from burrs and sharp edges and a method and apparatus for manufacturing it.

¹ A copy of the patent appears at Rec. p. 11.

Expanded metal *per se* dates back to 1862². Since 1885 it has been universally made by a process invented by one Golding, and described in the opinion of this Court in *Expanded Metal Co. v. Bradford*, 214 U. S. 366. While it does not appear from that decision, the method of manufacture there described inherently produces sharp edges and ragged burrs upon the edges of the strands, which frequently caused injury³, or even death⁴, to persons handling the product. Bound at the back of this volume are cuts showing expanded metal and a characteristic burr.

The presence of these inherent defects early gave rise to "an insistent demand for expanded metal which was free from burrs and sharp edges"⁵, and "long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it"⁶. But all of these efforts resulted in failure, and the problem remained unsolved for more than *forty years* until solved by Cross.

One of the concerns which tried, unsuccessfully, to satisfy this old and recognized want was respondent's predecessor, The North Western Expanded Metal Company⁷. North Western's try was induced by the rejection of a quantity of its expanded metal on the ground that it was *unsafe*, due to "Sharp edges or fins at the edges of openings" which were "very likely to cause lacerations, with an excellent chance of infection"⁸. The vendee reported the defect not merely to North Western,

² Rec. p. 2990.

³ Rec. pp. 2990-2991.

⁴ Rec. pp. 410-411.

⁵ Rec. p. 2882.

⁶ Rec. p. 2844.

⁷ Respondent succeeded to North Western's business April 1, 1930; Rec. p. 737. This was two years after Cross' date of invention.

⁸ Rec. p. 1956.

but also to the Underwriters' Laboratories, an organization which carries on a test and inspection service for insurers. This was in November, 1925. Through the succeeding months diligent efforts were made to improve the product, but in May, 1926, North Western's President, Mr. Foote, reported that it was "impossible" to eliminate "the rough or sharp edge" entirely, and that it was even impracticable to *minimize* the defect in any real degree, because "to do any better than we are doing" would require "dismantling the machines [in which the expanded metal is made] and grinding the knives so frequently that the cost would be prohibitive"⁹. The expedient of "grinding the knives" cannot eliminate the sharp edges. It does minimize their raggedness, but in so doing makes "an edge practically equivalent to *razor sharpness*"¹⁰.

The Cross invention is described in some detail in the brief accompanying this petition. It will suffice to say here that it utilizes the action of a high-speed rotary wire-bristled brush, applied to the expanded metal in a novel way. That the manner of application of the brush to the metal is important is shown by the fact that North Western's President, in his May 1926 letter⁹, said he had investigated the possibilities of using a wire brush, but "That did not work for various reasons, principally due to the *peculiarity of the material itself and the shape of the mesh*".

North Western also tried sand blasting without success.⁹

Petitioner has put the Cross invention into commercial use. The safe material went on the market in the Summer of 1931¹, and completely satisfied the forty-

⁹ Rec. p. 1973.

¹⁰ Rec. p. 184. Where italics appear in quotations, it will be understood that the emphasis is ours.

¹ Rec. p. 189.

year-old demand. It has had a marked commercial success and has displaced the unbrushed, unsafe material which was all the trade could theretofore supply. Late in 1931 or early in 1932—the date is not fixed precisely—respondent appropriated the invention and began competitive manufacture and sale at the insistence of its sales department². Prior to this respondent had been experimenting with the use of tumbling barrels to remove the burrs³, apparently without success.

The case was referred to a Special Master for trial. Although denying infringement in its answer⁴, respondent admitted infringement at the trial⁵ and consequently the sole issue was the validity of the patent. In the teeth of the facts, above recounted, as to the failures of its predecessor, North Western, to solve the problem, respondent based its defense in large measure on the defense that North Western had itself practiced the subject-matter of the patent prior to Cross. The Master rejected this and other prior use defenses, but nevertheless recommended the dismissal of the bill, on the following principal grounds:

The sole apparatus claim in suit (No. 18) was held invalid for lack of invention over Buckman patents 451,263 and 451,264, dated April 28, 1891⁶, and over two machines of the American Brass Company⁷. The Master conceded that none of these items of prior art had ever taught or been used for the treatment of expanded metal to remove burrs and sharp edges. The product claims (Nos. 15 and 16) were held invalid, claim 15 on

² Rec. p. 378.

³ Rec. p. 376.

⁴ Rec. p. 19.

⁵ Rec. p. 2893.

⁶ Rec. p. 2825. The Buckman patents were conceded by respondent's expert to be the most pertinent prior art; Rec. p. 541.

⁷ Rec. pp. 2841-2842.

the ground that it was drawn to subject-matter which was not inventive in character⁸ and claim 16 on the grounds that the patentee did not himself first reduce his conception of the product to practice nor show how it could be done, but that this was first done by The Manufacturers Brush Company in Cleveland, albeit on Cross' suggestion and at his behest⁹, and that there was lack of invention¹. The Master held that claim 16 was patentably distinct from claim 15. The method claims in suit (Nos. 10 to 14 inclusive) were held invalid on the ground that while "no prior art patents in evidence specifically disclose the method", they lacked invention over the prior art².

Both parties filed objections to the report. The District Judge overruled all of respondent's objections and sustained petitioner's principal objections, holding that the proper application of "authoritative patent decisions" to the facts required a holding that invention was present³.

So far as concerned the holding of the Special Master that The Manufacturers Brush Company, rather than Cross, had first reduced Cross' concept to practice, the District Judge held that the defense had not been made out; that, although the trial had been held in Cleveland, no witnesses had been called by respondent from the local plant to corroborate or to establish by necessary proof the alleged reduction to practice; that the incident "was a part of the Cross experiments and

⁸ Rec. p. 2888.

⁹ Rec. p. 2882.

¹ Rec. p. 2883.

² Rec. pp. 2892-2893.

³ Rec. pp. 2924-2927.

search for means and methods" and that whatever was done there inured to Cross' benefit⁴.

The District Judge sustained the Master's holding that product claim 15 was invalid⁵, and petitioner thereupon filed a disclaimer as to it⁶.

Respondent appealed to the Circuit Court of Appeals but did not challenge the holding of the District Court in rejecting the alleged North Western prior use or any other alleged use. The Court of Appeals reversed the District Judge as to all claims held valid by him, primarily on the ground that what Cross had done, although an "advance", lay "within the expected skill of the art"⁷. It disagreed with the Master's conclusion that claim 16 differed patentably from claim 15, now disclaimed, and held claim 16 invalid for that additional reason.

Reasons Relied Upon for the Allowance of the Writ.

Petitioner seeks no review of the evidentiary facts; cf. *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 365. The discretionary power of the Court is invoked on the following grounds:

I. *Diversity of opinion in the courts below. No other opportunity to present the case.* The District Court, applying what it deemed to be the proper application of "authoritative patent decisions" to the facts "that there was objection in the industry to sharp edges and burrs; that there was a demand for sheets without sharp edges; and that, many others had considered smooth edged fabric a desirable product and had made various efforts to make it" and that "the Cross patent was the solution and the response to that objection and demand", found invention present and the patent conse-

⁴ Rec. p. 2926.

⁵ Rec. p. 2930.

⁶ Rec. p. 2936.

⁷ Rec. p. 2994.

quently valid, save for one product claim (No. 15), now disclaimed. The Court of Appeals, holding in substance that the decisions of this Court, applicable to such a state of facts, were nullified by the decisions in the *Schriber-Schroth* cases, 305 U. S. 47 and 311 U. S. 211, when considered in the light of its own prior holdings therein, concluded that these facts were not of moment, held that no invention was involved, and reversed the District Court. It is plain, from the respective opinions, that the diversity between the courts below is solely on the legal principles to be applied to agreed or undisputed facts.

The affidavit of Lewis McC. Steenrod filed herewith shows a concentration of the industry in the Sixth Circuit, together with other facts which render further litigation, resulting in conflict of decision among circuits, wholly improbable; cf. *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U. S. 86, 89; *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 305 U. S. 47, 50.

II. *Misunderstanding and misapplication, by the Court of Appeals, of decisions of this Court.* The decision of the Court of Appeals shows that the holdings of this Court in the *Schriber-Schroth* cases were deemed by it to be controlling on the issue of *invention*. The Court of Appeals misapprehended the *ratio decidendi* of those decisions. Neither of the decisions of this Court in the *Schriber-Schroth* litigation denied the existence of an invention. The decisions were on grounds wholly foreign to that question; namely, lack of original disclosure to support the claims (305 U. S. 47), and file wrapper estoppel (311 U. S. 211); yet Judge SIMONS' opinion in the case at bar holds, in essence, that because this Court reversed him in the *Schriber-Schroth* litigation this Court's decisions stating the affirmative rule of *invention* are nullified. The misunderstanding and misapplication of the *Schriber-Schroth* decisions by the Court of Ap-

peals is ground for certiorari; *Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 311 U. S. 211, 217; *Webster Electric Co. v. Splitdorf Electrical Co.*, 264 U. S. 463, 469.

III. *Failure to apply the applicable decisions of this Court.*

(a) The Court of Appeals conceded that there was no *anticipation* of the subject-matter of the patent, and that "adaptation" of the prior art disclosures would be required in order to effect Cross' "*advance*"¹, but held what he had done lay "within the expected skill of the art", despite the facts that "for many years there had been an insistent demand for such metal without the sharp edges"²; that "this record is replete with evidence introduced in behalf of both parties which is convincing that long before Cross many others had considered such smooth edged fabric as a desirable product, and had made various efforts to make it"³; that the problem had been worked at diligently by respondent's predecessor, whose President had finally characterized it as "impossible" of solution; that only after it had existed for more than *forty years* had it been solved by the patentee, Cross; and that the closest item of prior art had existed for *thirty-seven* of those forty years, without anyone seeing in it any solution of the problem.

Most of the rules of law for determining the question of invention are negative in their character, but this Court has long adhered to one affirmative rule; namely:

"Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere

¹ Rec. p. 2992, p. 2994.

² Rec. p. 2850.

³ Rec. p. 2844.

skill of the art would normally have been called into action by the generally known want"; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474.

This rule, we submit, is controlling on the facts of the present case. But the Court of Appeals, on the ground that decisions prior to the *Schriber-Schroth* cases "are not very helpful"⁴; that the patent law is "presently in a state of flux"⁴; and because of the holdings of this Court in the *Schriber-Schroth* cases adverse to the patents there involved, despite "The evidence there of a long felt need and commercial acceptance of a solution * * * fully as dramatic as that here presented, if, indeed, not more so"⁵, refused to apply to the case at bar the rule of this Court laid down in the *Paramount* case and the long line of earlier decisions cited therein.

(b) The District Judge held that the adoption of the subject-matter by the respondent "speaks with undeniable force" on the issue of invention⁶. The Circuit Court of Appeals rejected that holding specifically. In so doing it went contrary to the holdings of this Court in *Krementz v. The S. Cottle Company*, 148 U. S. 556, 560⁷, in view of the facts (i) that the President of respondent's predecessor had asserted the problem was "impossible" of solution⁸, and (ii) that respondent's own efforts to solve it were all failures. And the case was not one of "open and adverse possession" of the patent, as the Court of Appeals seemed to assume⁹, be-

⁴ Rec. p. 2994.

⁵ Rec. p. 2998.

⁶ Rec. p. 2926.

⁷ Cited with approval in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, 474.

⁸ Cf. *Krementz v. The S. Cottle Company*, 148 U. S. 556, 560.

⁹ Rec. p. 2990.

cause respondent appropriated the substance of the Cross development *before* the issuance of the patent in suit by securing information from the manufacturer who had supplied vital parts of petitioner's machine.

(c) In holding that the adaptations necessary to make the prior art disclosures effective to brush expanded metal must themselves involve invention in order to sustain the patent, the Court of Appeals went contrary to the rule laid down by this Court in *Hobbs v. Beach*, 180 U. S. 383, 392.¹⁰

(d) In holding the work done at Cross' behest by the Manufacturers Brush Company to be prior art against Cross, and in refusing to give him the benefit of it, the Court of Appeals went contrary to the rule laid down by this Court in *Agawam Company v. Jordan*, 7 Wall. 583, 602, and *Minerals Separation, Limited v. Hyde*, 242 U. S. 261, 270.

IV. Conflict with decisions of other Circuit Courts of Appeals.

(a) In relegating to limbo the rule of the *Paramount* case, above quoted, on the ground that the *Schriber-Schroth* cases are controlling on the question of *invention*, the Court of Appeals has rendered a decision in conflict with the decisions of other Circuit Courts of Appeals in cases subsequent to the *Schriber-Schroth* decisions, as follows:

Refractolite Corporation et al. v. Prismo Holding Corporation, 2nd Circuit (Feb. 24, 1941), 117 F. 2d 806, 807;

James P. Marsh Corp. v. United States Gauge Co., 7th Circuit (June 11, 1942) 129 F. 2d 161, 163-4.

¹⁰Cited with approval in *Paramount Public Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464. 474.

(b) In rejecting the proposition that respondent's imitation was persuasive on the question of invention, the Court of Appeals has enounced a rule in conflict with the rule in the Second Circuit; *Kurtz v. Belle Hat Lining Co.*, 280 F. 277, 281.

(c) In holding that the adaptations necessary to make the prior art disclosures effective to brush expanded metal must themselves involve invention in order to sustain the patent, the Court of Appeals has enounced a rule of law in conflict with the rule in the Second Circuit; *White v. Converse*, 20 F. 2d 311, *Traitel v. Hungerford*, 18 F. 2d 66; and with the rule in the Seventh Circuit; *Rousso v. City Towel Supply Co.*, 242 F. 655.

(d) In denying the patentee the benefit of whatever experimenting was done by The Manufacturers Brush Company, the Court of Appeals has rendered a decision in conflict with the rule of law of the Circuit Court of Appeals for the District of Columbia; *Massey v. Ridge*, 270 F. 879; *Orcutt v. McDonald*, 27 App. D. C. 228.

V. *Public Importance.* The wide-spread discussion of the present day on the question of invention is doubtless known to the Court¹. The mere fact that members of the general public, and even scientists, have failed to discriminate between decisions on technical grounds, such as alteration of original disclosure and file-wrapper estoppel, on the one hand, and questions of invention on the other hand, is perhaps not to be deemed necessary of correction and enlightenment by this Court. But when, as in the case at bar, a Circuit Court of Appeals, which will ordinarily be the court of last resort of patentees in

¹ And see, for example, "Collier's" magazine, issue of Jan. 10, 1942, p. 54, editorial entitled "Fifteen to Nothing".

an important industrial section of the United States, deprives litigants of the benefit of the only affirmative rule of invention laid down by this Court, on the mistaken ground that it has been superseded by decisions which did not turn on the question of invention but rather on the technical grounds of alteration in original disclosure and file-wrapper estoppel, it is, we submit, of the utmost public importance that this Court exercise its discretionary powers and grant a review. Otherwise, patentees will be deprived of a just presumption and the incentives to invent and to invest in and commercialize inventions will be materially impaired, to the public detriment.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Court, directed to the Circuit Court of Appeals for the Sixth Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled in its docket, No. 8788, United States Gypsum Company, Appellant, v. The Consolidated Expanded Metal Companies, Appellee, and that the said judgment of the Circuit Court of Appeals for the Sixth Circuit may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

THE CONSOLIDATED EXPANDED METAL
COMPANIES

By WALTER J. BLENKO,
ARTHUR J. HUDSON,
Counsel for Petitioner.

Affidavit of Lewis McC. Steenrod.

State of Pennsylvania }
County of Allegheny } ss.:

LEWIS McC. STEENROD, being duly sworn, deposes and says, upon information and belief:

1. I am and have been since 1935 President of petitioner, The Consolidated Expanded Metal Companies. I am familiar with the expanded metal business in the United States and with the expanded metal products made by the various manufacturers of expanded metal.

2. Expanded metal made in the United States falls into two classes: (a) expanded metal which is used for reinforcement purposes such as reinforcement of concrete and plaster or is incorporated in metal castings such as brake shoes, and (b) expanded metal which is used for making machine guards, window guards, partitions, walkways, baskets and the like where the expanded metal is exposed to contact of the hands, body and clothing of people. The patent in suit is concerned with the removal of sharp edges and burrs which render expanded metal dangerous for the uses of class (b).

3. The business of making expanded metal is largely concentrated in the Sixth Circuit. Except petitioner, the only manufacturer of expanded metal in the United States outside of the Sixth Circuit is Penn Metal Company of Parkersburg, West Virginia. Almost the entire expanded metal production of Penn Metal Company has been used for brake shoe reinforcement in class (a) where the expanded metal is not exposed to human contact in use. Penn Metal Company does not own the expanded metal making machines which it uses; these are owned by American Brake Shoe & Foundry Company, a brake shoe manufacturer. Penn Metal Com-

pany does not now remove and never has removed the burrs and sharp edges from its expanded metal.

4. The construction of a machine embodying the principles disclosed in the patent in suit would involve the use of a large amount of critical materials and, under present regulations of United States Government departments, it would be impossible at this time for any manufacturer wishing to use the subject-matter of the patent in suit to construct a machine for practicing it.

5. Because of the foregoing, it is presently impossible, and in all probability it will continue to be impossible, to institute litigation in any other circuit to test the validity of the patent in suit.

LEWIS McC. STEENROD.

Sworn to and subscribed before me, a Notary Public in and for the said County and State, this 28th day of November, 1942.

[NOTARIAL SEAL]

JANE H. KEITH,
Notary Public.

My commission expires May 11th, 1944.

